

DOCKET NO.: WYTH0146-101  
(AM100831 P1)

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PATENT

MAY 16 2005

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: John C. McKew

Confirmation No.: 7235

Serial No.: 10/722,782

Group Art Unit: 1624

Filed: November 26, 2003

Examiner: HABTE, KAHSAY

Title: PROCESS FOR MAKING AN ALDEHYDE

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On May 16, 2005

  
Michael Straher Reg. No. 38,325

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

## RESPONSE TO THE RESTRICTION REQUIREMENT

The present Response is filed in regard to the Restriction Requirement mailed February 14, 2005 in connection with the above-identified patent application.

The Examiner has mistakenly restricted claims 1-14 into 10 groups. Group I contains claims 1-3 (in part) drawn to AA being pyrimidinyl, classified in class 544, subclass 242. Group II contains claims 1-3 (in part) drawn to AA being quinolinyl and isoquinolinyl, classified in class 546, subclass 139 and 152. Group III contains claims 1-3 (in part) drawn to AA being pyridinyl, classified in class 546, subclass 314. Group IV contains claims 1-3 (in part) drawn to AA being oxazolyl and isoxazolyl, classified in class 548, subclass 215 and 240. Group V contains claims 1-3 (in part) drawn to AA being thioazolyl, classified in class 548, subclass 146

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and 206. Group VI contains claims 1-4 (in part) and 8-14, drawn to AA being indolyl, classified in class 548 and subclass 469. Group VII contains claims 1-3 (in part) drawn to AA being pyrrolyl and furyl, classified in class 548, subclass 530 and in class 549, subclass 429. Group VIII contains claims 1-7 (in part) drawn to AA being phenyl, naphthyl and biphenyl (no heteroatom in the ring), classified in class 568, subclass various. Group IX contains claims 1-3 (in part) drawn to AA being alkenyl or alkynyl (no ring), classified in class various, subclass various. Group X contains claims 1-3 (in part) drawn to AA being others (Groups that do not fall into Groups I-IX), classified in class various, subclass various.

Solely to comply with the present restriction, Applicant elects Group VI (AA = indolyl), containing claims 1-4 (in part) and 8-14, with traverse.

In substantiating a proper restriction of the claims in an application, the Office Action must satisfy two criteria. First, the Office Action must show that the application claims independent or distinct inventions. Second, the Office Action must show that examining all claimed invention in a single application would constitute a serious burden. M.P.E.P. §803. Applicant respectfully asserts that the Office Action has not satisfied the criteria for substantiating a proper restriction of the claims.

Specifically, the Office Action has not shown that conducting a prior art search for claims 1-14 would constitute a serious burden. And, in fact, conducting a prior art search for these claims would not constitute a serious burden to the Office. As the claims clearly recite, the present invention provides a process of converting a dihalomethyl compounds to an aldehyde. A prior art search for the conversion of a dihalomethyl compound to an aldehyde is a straight forward search, and the Office has the resource to conduct this search without burden.

Further, Applicant respectfully reminds the Office that the Office cannot refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention.<sup>1</sup> The USPTO defines unity of invention as follows:

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<sup>1</sup> The Court of Customs and Patent Appeals ("CCPA") held in *In re Weber*, 580 F.2d 455, 458-49, 198 U.S.P.Q. 328, 331-332.

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Broadly, the unity of invention exists where compounds included within a Markush group  
(1) share a common utility, and  
(2) share a substantial structural feature disclosed as being essential to that utility.

MPEP §803.02 (citing *In re Harnish*, 631 F.2d 716, 206 USPQ2d 1059 (Bd. Pat. App. & Int. 1984)).<sup>2</sup>

The present restriction of the claims into ten Groups is improper for at least the reason that such restriction amounts to refusing to examine claim 2, which recites a Markush group containing dihalomethyl compounds (and which correspond to the various dihalomethyl compounds identified by the Office in the ten restricted Groups).

Clearly, the subject matter in claim 2 has both unity of invention, and a shared structural feature. Specifically, all the dihalomethyl compounds recited in the Markush group share the common utility of being used as a reagent for forming an aldehyde, and also possess the shared structural feature that is essential to the utility (the dihalomethyl group from which the aldehyde is formed). Since the subject matter in claim 2 has unity of invention, the subject matter of the Markush group should be examined together in this application. The present restriction into ten Groups is therefore improper, and amounts to a refusal to examine claim 2 in its entirety. Thus, the Office should withdraw the restriction requirement and examine all the claims.

Should the Office persist in the present restriction, Applicant respectfully requests supervisory review of the restriction.

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(CCPA 1978), that the United States Patent and Trademark Office ("USPTO") cannot require an applicant to divide up the embodiments of a single Markush claim. The invention in *Weber* was related to cyclic diamine derivatives possessing a common psychotherapeutic property and identified by a single generic formula expressed in Markush format. The examiner found that the main claim embraced 24 enumerated independent and distinct inventions. The examiner sought to divide the claim by rejecting it as an improper Markush claim and under 35 USC §121 for misjoinder. The court viewed the rejection as tantamount to a refusal to examine the claims. 35 U.S.C. §121 gives the USPTO authority to restrict between claims of an application reciting one or more independent and distinct inventions. *In re Weber*, 580 F.2d at 458, 198 USPQ at 331-332. It does not, however, provide authority to reject a claim on that basis, with the idea of requiring an applicant to break up the claim and present it in several applications. *Id.*, 198 USPQ at 332. An applicant has a statutory right to claim an invention as he sees fit. *Id.*

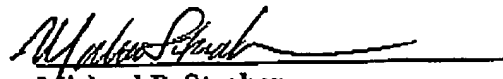
<sup>2</sup> The Markush claims in *Harnish* defined certain compounds having a single structural similarity (a single core structure called a "coumarin group") and possessing the same utility as dyestuffs. In holding that unity of invention existed for these claims, the CCPA found that these two properties (the single structural similarity and single utility) sufficiently circumscribed a genus of a single invention. *In re Harnish*, 631 F.2d at 722, 206 USPQ at 305.

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**FILED: May 16, 2005**

Applicants submit that the present response is complete and complies with the requirements of 35 U.S.C. §121. In addition, Applicants' submit that claims 1-14 must be considered in the present application without restriction.

Respectfully submitted,

  
Michael P. Straher  
Reg. No. 38,325

Date: May 16, 2005

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MESSAGE: OFFICIAL FAX!!!

Serial No. 10/722,782 filed 11/26/03  
Transmittal Form (1 page)  
Fee Transmittal in dup. (2 pages)  
Request for 2 Month Extension in dup. (2 pages)  
Response to Restriction Requirement (4 pages)

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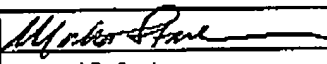
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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/722,782
	Filing Date	11/26/03
	First Named Inventor	John C. McKew
	Art Unit	1624
	Examiner Name	Kahsay Habte
	Attorney Docket Number	WYTH0146-101 (AM100831 P1)
Total Number of Pages in This Submission		

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<b>Remarks</b> SENT 5/16/05 VIA FACSIMILE		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	Cozen O'Connor		
Signature			
Printed Name	Michael P. Straher		
Date	5/16/05	Reg. No.	39.325

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Signature			
Typed or printed name	Michael P. Straher	Date	5/16/05

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Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).		Complete if Known	
<b>FEE TRANSMITTAL</b> <b>for FY 2005</b>		Application Number	10/722,782
		Filing Date	11/28/03
		First Named Inventor	John C. McKew
		Examiner Name	Kahsay Hable
		Art Unit	1624
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Attorney Docket No.	WYTH0146-101 (AM100831 P1)
<b>TOTAL AMOUNT OF PAYMENT</b>		<b>(\$)</b> 450	

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Extra Claims	Fee (\$)
14	-20 or HP= 0	x _____ = 0
HP = highest number of total claims paid for, if greater than 20.		
Indep. Claims	Extra Claims	Fee (\$)
1	-3 or HP= 3	x _____ = 0
HP = highest number of independent claims paid for, if greater than 3.		

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).


Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
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**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)  
 Other (e.g., late filing surcharge): Petition for Ext.

**Fees Paid (\$)**  
 \_\_\_\_\_  
 450

**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent)	58,325	Telephone	215 665 2000
Name (Print/Type)	Michael P. Suraher	Date	May 16, 2005		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Effective on 12/08/2004.  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL  
for FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 450

## Complete If Known

Application Number	10/722,782
Filing Date	11/28/03
First Named Inventor	John C. McKew
Examiner Name	Kahsay Habto
Art Unit	1824
Attorney Docket No.	WYTH0148-101 (AM100831 P1)

**METHOD OF PAYMENT (check all that apply)**☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify) :☒ Deposit Account Deposit Account Number: 50-1275

Deposit Account Name: Cozen O'Connor

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s)☒ Credit any overpayments

Under 37 CFR 1.16 and 1.17

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 (including Reissues)

Small Entity Fee (\$)

50 25

Each independent claim over 3 (including Reissues)

200 100

Multiple dependent claims

360 180

**Total Claims****Extra Claims****Fee (\$)****Fee Paid (\$)**

14 -20 or HP= 0 x \_\_\_\_\_ = 0

HP = highest number of total claims paid for, if greater than 20.

**Indep. Claims****Extra Claims****Fee (\$)****Fee Paid (\$)**

1 -3 or HP= 3 x \_\_\_\_\_ = 0

HP = highest number of independent claims paid for, if greater than 3.

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Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	- 100 = _____	/ 50 = _____ (round up to a whole number) x _____	= _____	_____

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)


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**Fees Paid (\$)**

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**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent)	58,325	Telephone	215 665 2000
Name (Print/Type)	Michael P. Straher	Date	May 18, 2005		

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